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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

85503083

BRS INVESTMENT PROPERTIES, LLC,

Opposer,

vs.

ZANNIER SAS,

Applicant.

Opp. No.: 91210652

**ANSWER AND COUNTERCLAIM
UNDER SECTION 18 OF THE
TRADEMARK ACT**

ZANNIER SAS, a société par actions simplifiée, organized and existing under the laws of France (hereinafter "Applicant") hereby, by its undersigned attorney, Answers the Notice of Opposition filed by BRS Investment Properties, LLC (hereinafter "Opposer") and admits, denies and alleges as follows:

06/10/2013 SWILSON1 00000003 85503083

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 1 of the Notice of Opposition and therefore denies same.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 2 of the Notice of Opposition and therefore denies same.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 3 of the Notice of Opposition and therefore denies same.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth



06-07-2013

of the averments in numbered paragraph 4 of the Notice of Opposition and therefore denies same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 5 of the Notice of Opposition and therefore denies same.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 6 of the Notice of Opposition and therefore denies same.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 7 of the Notice of Opposition and therefore denies same.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 8 of the Notice of Opposition and therefore denies same.

9. Applicant denies the allegations of numbered paragraph 9 of the Notice of Opposition.

10. Admitted.

11. Applicant denies the allegations of numbered paragraph 11 of the Notice of Opposition.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 12 of the Notice of Opposition and therefore denies same.

13. Applicant denies the allegations of numbered paragraph 13 of the Notice of Opposition.

14. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 14 of the Notice of Opposition and therefore denies same.

15. Applicant denies the allegations of numbered paragraph 15 of the Notice of Opposition.
16. Applicant denies the allegations of numbered paragraph 16 of the Notice of Opposition.
17. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 17 of the Notice of Opposition and therefore denies same.
18. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 18 of the Notice of Opposition and therefore denies same.
19. Admitted.
20. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in numbered paragraph 20 of the Notice of Opposition and therefore denies same.
21. Applicant denies the allegations of numbered paragraph 21 of the Notice of Opposition.
22. Applicant denies the allegations of numbered paragraph 22 of the Notice of Opposition.
23. Applicant denies the allegations of numbered paragraph 23 of the Notice of Opposition.
24. Applicant denies the allegations of numbered paragraph 24 of the Notice of Opposition.
25. Applicant denies the allegations of numbered paragraph 25 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

First Affirmative Defense

The Notice of Opposition fails to state a claim upon which relief can be granted to Opposer.

Second Affirmative Defense

Applicant's use of its applied for mark is not likely to cause confusion with Opposer's alleged pleaded marks.

Third Affirmative Defense

The marks at issue differ in sound, appearance, meaning, and commercial impression.

Fourth Affirmative Defense

The respective goods/services, channels of trade, marketing and distribution of the goods/services at issue differ.

Fifth Affirmative Defense

There has been no actual confusion between the respective marks in the marketplace and Opposer's claims are time barred.

COUNTERCLAIM UNDER SECTION 18

1. Opposer alleges that it is the owner of the trademark registration of BACARA, Reg. No. 2,589,271, for "Clothing, namely, sweatshirts and sweatpants, shirts, jackets, ties, sweaters, caps, visors, hats, robes, swimwear, socks".
2. Upon information and belief, Opposer's primary business is providing resort and spa services and it does so under its mark BACARA and variations thereof.
3. Upon information and belief, Opposer only sells goods in Class 25 bearing the mark BACARA, if at all, to promote its aforesaid services.
4. Upon information and belief, Opposer sells goods in Class 25 bearing the mark BACARA, if at all, only on its premises and through its website to promote its resorts and spas.
5. Opposer's aforementioned U.S. registration of BACARA, Reg. No. 2,589,271, is overly broad and not specific to Opposer's current use in commerce, if any, of the mark BACARA.
6. While Applicant does not believe there is a likelihood of confusion

between the applied or mark and Opposer's pleaded marks, should the Board find a likelihood of confusion between them, the entry of a limitation of Opposer's registrations of BACARA, Reg. No. 2,589,271, reflecting how Opposer is actually using in commerce said mark, if at all, will avoid a finding of likelihood of confusion. Specifically, the Board should restrict Opposer's registrations of BACARA, Reg. No. 2,589,271, to, "Clothing, namely, sweatshirts and sweatpants, shirts, jackets, ties, sweaters, caps, visors, hats, robes, swimwear, socks only offered for sale on Registrant's premises and through Registrant's website to promote its resorts and spas".

WHEREFORE, Applicant believes that should the Board find a likelihood of confusion between the applied for mark and Opposer's trademark BACARA in Class 25, the failure of the Board to enter a limitation of Opposer's registration of BACARA, Reg. No. 2,589,271, reflecting how Opposer is actually using in commerce its pleaded mark in Class 25, if at all, will result in damage to Applicant.

Respectfully, submitted,

EPSTEIN DRANGEL, LLP
Attorneys for Applicant

Dated: June 6, 2013

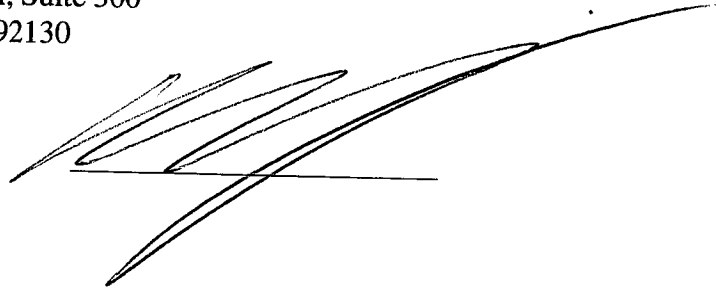
By: 

William C. Wright
Jason M. Drangel
60 East 42nd Street, Suite 2410
New York, NY 10165
Tel: 212-292-5390
Fax: 212-292-5391

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM UNDER SECTION 18 was served by First Class Mail, with sufficient postage prepaid, on this 6th day of June, 2013, upon Opposer's attorney:

Michelle L Mehok
Pillsbury Winthrop Shaw Pittman LLP
12255 El Camino Real, Suite 300
San Diego, CA 92130

A handwritten signature in black ink, appearing to read 'Michelle L Mehok', is written over a horizontal line.

CERTIFICATE OF MAILING

I hereby certify that the foregoing ANSWER AND COUNTERCLAIM UNDER SECTION 18 OF THE TRADEMARK ACT (Opposition No. 91210652) is being deposited with Federal Express (Tracking Number 7999 3688 6784), in an envelope addressed to: U.S. Trademark and Appeal Board, TTAB, 600 Dulany Street, Madison East, Concourse Level Rm C 55, Alexandria, VA 22313, on this 06th day of June 2013

Dated: New York, New York

By: Mireya Claudio Abad
Mireya Claudio-Abad